

**REMARKS**

**I. Introduction**

Claims 1, 2, 4-51, and 54 and 55 are currently pending. Claims 3, 52, and 53 were previously cancelled and claims 2, 4, 5 and 8-53 were withdrawn by the Examiner following a restriction requirement.

Claim 1 has been amended to clarify the claim terms.

No new matter has been added.

For the following reasons this application should be allowed and the case passed to issue.

**II. Claim Rejections Under 35 U.S.C. § 102(b)**

**A. Hattori et al., Japan Patent Publication 5-218035 (“Hattori”)**

Claims 1, 6, 7 and 54 were rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by Hattori et al., Japan Patent Publication 5-218035 (“Hattori”). Applicants respectfully disagree.

Claim 1 recites in pertinent part, “wherein the metal compound film contains at least one of the elements forming the insulation film and is made of at least one selected from a group consisting of Zr, Hf, W, V, Mo, Os, Rh, Ir, Pd and Pt or any alloy thereof.”

Anticipation under 35 U.S.C. § 102 requires that “each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.”

*Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ 2d 1051, 1053 (Fed Cir. 1987). At a minimum, the cited prior art does not disclose (expressly or inherently) a configuration, wherein the metal compound film contains at least one of the elements forming the insulation film and is made of at least one selected from a group consisting of Zr, Hf, W, V, Mo, Os, Rh, Ir, Pd and Pt or any alloy thereof.”

The Examiner asserts on page 3 of the Office Action dated July 15, 2008, that Hattori teaches a RuO<sub>2</sub> barrier metal film and further alleges that the metal film is “made of at least one selected from consisting of Ti, Zr, hf, Nb, W, V, Mo, Os, **Rh**, Ir, Pd and Pt or **any alloy thereof.**” [sic, emphasis in original]. As is well known in the art, Ru is ruthenium and Rh is rhodium. Applicants respectfully point out that Hattori simply does not teach or suggest the presence of Rh, or any of the elements or alloys of the elements currently recited in claim 1.

Accordingly, Applicants respectfully submit that claim 1 is allowable over the cited prior art.

Furthermore, claims 6, 7, 54 and 55 depend from and further define the subject matter of claim 1 and therefore are also allowable.

**B. Ito et al., U.S. Patent Application Publication No. 2003/0116854 (“Ito”)**

Claims 1, 6, 7, 54 and 55 were rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by Ito et al., U.S. Patent Application Publication No. 2003/0116854 (“Ito”).

Applicants respectfully disagree. However, in the interest of expediting prosecution, claim 1 has been amended and now recites, in pertinent part, “wherein the metal compound film contains at least one of the elements forming the insulation film and is made of at least one selected from a group consisting of Zr, Hf, W, V, Mo, Os, Rh, Ir, Pd and Pt or any alloy thereof.”

Ito does not teach or suggest such a configuration as recited in claim 1.

Accordingly, claim 1 is allowable over the cited prior art references.

Furthermore, claims 6, 7, 54 and 55 depend from and further define the subject matter of claim 1, and therefore should also be allowed.

**III. Claim Rejections Under 35 U.S.C. § 102(e)**

Claims 1, 6, 7, 54 and 55 were rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by Shimizu et al., U.S. Patent Application Publication No. 2007/0252280 (“Shimizu”). Applicant respectfully disagree. However, in the interest of expediting prosecution, claim 1 has been amended and now recites, in pertinent part, “wherein the metal compound film contains at least one of the elements forming the insulation film and is made of at least one selected from a group consisting of Zr, Hf, W, V, Mo, Os, Rh, Ir, Pd and Pt or any alloy thereof.”

Shimizu does not teach or suggest such a configuration as recited in claim 1.

Accordingly, claim 1 is allowable over the cited prior art references.

Furthermore, claims 6, 7, 54 and 55 depend from and further define the subject matter of claim 1, and therefore should also be allowed.

**IV. Conclusion**

In view of the above amendments and remarks, Applicants submit that this application should be allowed and the case passed to issue. If there are any questions regarding this Amendment or the application in general, a telephone call to the undersigned would be appreciated to expedite the prosecution of the application.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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